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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,558

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Horst Lange

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,558	Applicant(s) LANGE ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-13,18,20 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 4,14,17,19 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/07/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 2, 15, and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the claimed amino/ammoniopolysiloxane, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 10, 2009.

Specification

Pages 73 and 74 of the Specification are missing from the copy furnished to the USPTO.

Claim Objections

Claim 4 is objected to because it is not clear how an amine/ammonium group could be divalent insofar as nitrogen atoms normally bear at least three substituents.

Claim Analysis

Initially, Applicant characterizes their invention only as a, "amino- and/or ammoniopolysiloxane" bearing alkoxysilyl groups. Although the Examiner appreciates that the favored permutations of this genus of materials are those wherein the amine/ammonium group is incorporated into the backbone, the broadest description of their invention embraces any polysiloxane containing both amine/ammonium moieties and alkoxysilyl groups. That is, the Examiner believes that the aforementioned phrase does not connote any orientation of the amine/ammonium/alkoxysilyl groups relative to the siloxane backbone. Indeed, Law et al., U.S. Patent Application Publication No. 2003/0118381 alludes to a "polyamine polysiloxane", which is a nearly identical

description, wherein the amine moieties are pendant to, and at the terminal positions of, the polysiloxane backbone. (The Examiner cites this document simply to illustrate the suitability of his interpretation of the claims.) Moreover, claim 13 is further limiting of claim 4 and, by extension, claim 1. Because claim 13 is further-limiting of these claims, it must be true that polymer materials wherein the group "V" represents a terminal or pendant group are encompassed by claims 1 and 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, 6-7, 10-11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hierstetter et al., U.S. Patent # 5,990,334. Examples 4 and 8 both teach the employment of an α,ω - dimethylmethoxysilyl-terminated dimethylsiloxane aminopropylmethylsiloxane copolymer that satisfies the limitations of these claims.

Claims 1, 3-4, 6-13, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Westall, U.S. Patent # 4,417,066. The compound at the top of column 4 satisfies all the limitations of these claims in the Examiner's estimation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westall, U.S. Patent # 4,417,066. Westall contemplates the treatment of textiles with the compounds that represent their invention to impart lubricity and soft hand (column 2, lines 65-68). However, there is no express suggestion to include these compounds in detergent formulations. On the other hand, while compositions formulated expressly for softening are known, there are also any number of commercial products that comprise both detergents and softeners. Further, these detergent compositions are usually prepared as emulsions.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 7, and 13 are provisionally rejected on the ground of nonstatutory double patenting over claims 1 and 5 of copending Application No. 11/909,621. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

There is overlap in the polymers embraced by these claims where the V^2 moiety of the co-pending invention disclosure is substituted with the group $\text{Si}(\text{OR})_{3-a}(\text{R}')_a$. It should be noted that the description of the variable "V" in the instant claims is sufficiently broad so as to encompass all of the permutations of V^1 - V^3 .

Claims 1, 4, 7, and 13 are provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 11/909,723. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

There is overlap in the polymers embraced by these claims where the V^2 moiety of the co-pending invention disclosure is substituted with the group $\text{Si}(\text{OR})_{3-a}(\text{R}')_a$. It

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should be noted that the description of the variable "V" in the instant claims is sufficiently broad so as to encompass all of the permutations of V^1 - V^3 .

Allowable Subject Matter

Claims 14, 17, 19, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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October 23, 2009

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796